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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,362	12/31/2003	Michael Palumbo	ATT/2003-0254	4922

26652 7590 02/09/2005

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EXAMINER

PARK, JOHN J

ART UNIT PAPER NUMBER

2876

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/750,362	<b>Applicant(s)</b> PALUMBO ET AL.	
	<b>Examiner</b> John J. Park	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

The inventor's signature for the 2<sup>nd</sup> inventor is missing. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7, 10, 11, 14, and 19 are rejected under 35 U.S.C. 102(b) as anticipated by Stimson et al. (U.S. patent No. 5,577,109).

Re claim 1, a method of providing digital content to consumers (See Col. 1 Line 10-13), comprising:

receiving unique identification information associated with a prepaid digital content medium (PDCM) from a consumer distributor of said PDCM (See Col. 2 Line 16-20);

activating said PDCM based upon said unique identification information (See Col. 4 Line 52-57); and

sending confirmation of activation of said PDCM in response to a request for confirmation from a digital content provider, said digital content provider sending said request for confirmation in response to a request for said digital content by a consumer possessing said purchased PDCM (See Col. 6 Line 5-10).

Re claim 2, the method of claim 1 wherein said receiving step comprises:  
receiving a digital signal comprising a serial number and personal identification number associated with said PDCM (See Col. 6 Line 30-34).

Re claim 3, the method of claim 1 wherein said activating step comprises:  
comparing said received identification information to identification information stored in a database (See Col. 3 Line 15-21); and  
in response to said received and stored identification information matching, providing an indicia of activation for said PDCM (See Col. 7 Line 12-25).

Re claim 4, the method of claim 3 wherein said activating step further comprises:  
determining whether said PDCM has been purchased by a consumer (See Col. 3 Line 17-21); and  
providing indicia of purchase associated with said PDCM (See Col. 2 Line 50-60).

Re claim 5, the method of claim 4 further comprising rejecting activation from said consumer distributor in an instance where said received and stored identification information fails to match (See Col. 5 Line 47-54).

Re claim 7, the method of claim 1, wherein said sending confirmation of activation of said PDCM comprises:

receiving an activation request from said digital content provider (See Col. 6 Line 6-8):

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querying a database for an indicia of activation associated with said PDCM (See Col. 2 Line 50-60); and

sending said confirmation of activation to said digital content provider in an instance said PDCM is activated (See Col. 6 Line 9-12).

Re claim 10, the method of claim 1 wherein said digital content provider sending said request for confirmation in response to a request for said digital content by a consumer possessing said purchased PDCM comprises (See Col. 3 Line 7-21):

receiving, at said digital content provider, said request for digital content from a consumer computer device associated with said consumer (See Col. 4 Line 30-36); and

downloading said digital content from said content provider to said consumer computer device in an instance where said PDCM is confirmed as being activated and said consumer is registered with said content provider (See Col. 2 Line 10-20).

Re claim 11, a system for providing digital content, comprising:

a prepaid digital content medium (PDCM) comprising unique identification information thereon (See Col. 2 Line 16-20);

a PDCM consumer distributor for selling said PDCM (See Col. 4 Line 30-33);

a digital content provider for storing said digital content associated with said PDCM, said digital content provider adapted for communication with a consumer computer device to request and receive said digital content (See Fig. 1); and

an authentication service provider for maintaining corresponding identification information associated with said PDCM, said authentication service provider adapted to activate said PDCM upon receiving notice of purchase of said PDCM, said authentication service

provider sending confirmation of activation of said PDCM in response to a request for confirmation from said digital content provider, wherein said digital content provider sends said request for confirmation in response to said consumer computer device requesting to receive said digital content from said service provider (See Col. 2 Line 42-Col. 3 Line 6).

Re claim 14, the system of claim 11, wherein said identification information of said PDCM comprises a serial number and a personal identification number (See Col. 6 Line 30-34).

Re claim 19, a method for providing digital content using a prepaid digital content medium (PDCM), comprising:

activating said PDCM at an authentication service provider (See Col. 3 Line 1-6) in response to receiving identifying and purchase information associated with said PDCM from a distributor of said PDCM (See Col. 2 Line 16-20); and

providing said digital content to a computer device of a user from a digital content provider, in an instance where said user is registered with said digital content provider, and said identifying and purchasing information associated with said PDCM is reconfirmed as being activated by said authentication service provider (See col. 2 Line 50-60).

Therefore, Stimson et al. reasonably can be read to describe every limitation of claims 1-5, 7, 10, 11, 14, and 19.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al. (U.S. patent No. 5,577,109) in view of Dawson (U.S. patent No. 6,832,720).

Re claim 6, Stimson et al. disclose pre-paid card systems having a remote terminal to provide on-site activation and recharging of cards (See Col. 1 Line 10-13). Each of the pre-paid cards has a security number (See Col. 2 Line 16-20), and a data terminal operator enters the number to enable point-of-sale activation or recharging of the card (See Col. 2 Line 62-67). After communicating with a host, transmitting a request, and receiving verification, the unit displays a suitable response message (See Col. 6 Line 5-13).

However, Stimson et al. fail to teach rejecting activation from a consumer distributor in an instance where the PDCM has not been purchased by a consumer.

Dawson discloses that cards are shipped in an inactivated state to a retail distribution point and the card numbers is recorded in the database to minimize potential losses due to theft, fraud, or mishaps in transit (See Col. 6 Line 23-31).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ cards with an inactivated state and a record in the database as taught by Dawson into the teachings of Stimson et al. in order to apply the card with inactivation status and recoding the card identification number on a main database that it would prevent any mistreat of the card for better safety of the prepaid card.

Re claim 8, the teachings of Stimson et al. have been discussed above.

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However, Stimson et al. fail to teach sending notice of non-activation of said PDCM to said digital content provider in response to said request for confirmation from said digital content provider, in an instance where said PDCM is not activated.

Dawson discloses that an appropriate message is transmitted to the originating data terminal when the activation is refused (See Col. 6 Line 58-65).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a message for rejection of activation to a data terminal as taught by Dawson into the teachings of Stimson et al. in order to send a message of activation process to a data terminal from a host computer after examine validation process for better communication with a consumer.

Re claim 9, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach sending notice of non-activation of said PDCM comprises: receiving an activation request from said digital content provider; querying a database for an indicia of activation associated with said PDCM; and sending said notice of non-activation to said digital content provider in an instance said PDCM is not activated.

Dawson discloses that a host computer may check whether the activation transaction is originating from a data terminal associated with the intended customer, and any refusal of activation would be signaled to the originating data terminal (See Col. 6 Line 47-65).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ activation and signaling method of a host computer during transaction as taught by Dawson into the teachings of Stimson et al. in order to provide the



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activation and signaling process to a host computer that it would distinguish and notice any activation refusal to a consumer for safer transaction.

Re claim 12, Stimson et al. disclose pre-paid card systems having a remote terminal to provide on-site activation and recharging of cards (See Col. 1 Line 10-13). Each of the pre-paid cards has a security number (See Col. 2 Line 16-20), and each of terminals is located at a point-of-sale location where a pre-paid card sold to users (See Col. 4 Line 30-36). After communicating with a host, transmitting a request, and receiving verification, the unit displays a suitable response message (See Fig.1). By keeping track of the number and the identification of the data terminal, the system can generate accounting and/or billing information so that system operator can determine authorization (See Col. 3 Line 1-6).

However, Stimson et al. fail to teach that said PDCM comprises a card having a magnetic strip.

Dawson discloses a magnetic stripe on the packaging means of a debit card (See 202 in Fig. 1).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a magnetic stripe on the packaging means of a debit card as taught by Dawson into the teachings of Stimson et al. in order to provide the magnetic stripe on the pre-paid card that it would bear an encoded representation of a card identification number for scanning by a terminal.

Re claim 13, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach a PDCM scanning device being capable of sending said unique identification information of said PDCM to said authentication service provider.

Dawson discloses a scanning method at a terminal for reading and transmitting the encoded representation from the packaging means of a debit card to a remote processing center for testing of the representation to determine whether the debit card should be activated (See Col. 3 Line 1-8).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the scanning method at a terminal for reading and transmitting the encoded representation as taught by Dawson into the teachings of Stimson et al. in order to scan card identification number with a magnetic stripe to read and transmit it to a remote processing center for examining validation.

6. Claims 15-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al. (U.S. patent No. 5,577,109) in view of Wu (Pub No. U.S. 2003/0050041).

Re claim 15, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach that said digital content provider comprises: a web server; a storage device coupled to said web server, said storage device comprising digital content associated with said PDCM.

Wu discloses that a wireless stations are connected to the web access server to remotely access the Internet including the World Wide Web and download the corresponding page (See Fig. 1).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ web server using Internet to download content as taught by

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Wu into the teachings of Stimson et al. in order to provide Internet and web server to the transaction with a graphical user interface system for better accessing to digital information.

Re claim 16, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach that said digital content provider further comprises: an authentication, authorization, and accounting (AAA) server coupled to said storage device; and a PDCM database stored in said storage device.

Wu discloses that the information is transmitted to an authentication server for authenticating information to provide authorization to the system, and the authentication server reviews the information through a central database containing the prepaid account information (See Col. 1 [0009]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ authentication server to review and authorize the prepaid account information as taught by Wu into the teachings of Stimson et al. in order to transmit the prepaid account information to the authentication server that it would review and authorize through a central database for secure transaction.

Re Claim 17, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach that said customer computer device comprises at least one of a desktop computer, a laptop, a PDA, and a cellular phone.

Wu discloses that a portable wireless medium may include mobile and personal computers, personal digital assistants, palmtop computers, handheld personal computers, and pen-based computers (See Col. 4 [0044]).

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Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a portable wireless medium as taught by Wu into the teachings of Stimson et al. in order to provide mobile and personal computers, personal digital assistants, palmtop computers, handheld personal computers, and pen-based computers as a consumer side device that it would connect host server through network for mobility.

Re claim 18, the teachings of Stimson et al. have been discussed above.

However, Stimson et al. fail to teach that said digital content comprises at least one of video, music, multi-media content, electronic books, and electronic data.

Wu discloses that the transmitted information may be in the form of data, video, voice, and combination (See Col. 2 [0025]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the form of data, video, voice, and combination as the transmitted information as taught by Wu into the teachings of Stimson et al. in order to transmit the forma of data, video, voice, and combination through a multimedia network with high capability for better network communication service.

Re claim 20, Stimson et al. disclose pre-paid card systems having a remote terminal to provide on-site activation and recharging of cards (See Col. 1 Line 10-13). By keeping track of the number and the identification of the data terminal, the system can generate accounting and/or billing information so that system operator can determine authorization (See Col. 3 Line 1-6). The data terminals are remote from the host computer and connectible for transmitting data between the terminals and the host computer (See Col. 4 Line 30-36).

However, Stimson et al. fail to teach that said digital content comprises at least one of video, music, multi-media content, electronic books, and electronic data.

Wu discloses that the transmitted information may be in the form of data, video, voice, and combination (See Col. 2 [0025]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the form of data, video, voice, and combination as the transmitted information as taught by Wu into the teachings of Stimson et al. in order to transmit the forma of data, video, voice, and combination through a multimedia network with high capability for better network communication service.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stich et al. (U.S. patent No. 5,760,381) disclose a debit cards packaged and mounted for point of purchase display with inactive manner until activation at the point of purchase; Goade (U.S. patent No. 5,609,253) discloses a packaging and method for displaying a card with coded data disposed on one side.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Park whose telephone number is 571-272-2350. The examiner can normally be reached on 5:30am - 2:00pm (Monday - Friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John J Park  
Examiner  
Art Unit 2876

  
STEVEN S. PAIK  
PRIMARY EXAMINER